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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,329	08/04/2003	Philippe A. Charrin	156906-0016	6777
29000	7590	04/15/2005	EXAMINER LE, THIEN MINH	
IRELL & MANELLA LLP 1800 AVENUE OF THE STARS SUITE 900 LOS ANGELES, CA 90067			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,329

Applicant(s)

CHARRIN, PHILIPPE A.

Examiner

Thien M. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004 and 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The preliminary amendments filed on 2/9/2004 and 8/4/2003 have been entered. The information disclosure statement filed on 8/4/2003 has been entered. Receipt of the Terminal Disclaimer filed on 2/9/2004 is acknowledged. Claims 1-34 have been canceled. Claims 35-59 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 35-41, 48-49, and 51-59, are rejected under 35 U.S.C. 102(e) as being anticipated by Ramachandran (Ramachandran – 6,315,195).

Regarding claim 35, Ramachandran discloses a transaction apparatus (10) includes a multifunction card (12) and a portable terminal (14). The multifunction card includes a programmable memory (18) and a magnetic stripe (16) thereon. The programmable memory on the card is used to store indicia corresponding to account data which is input to the memory by reading with the terminal magnetic stripe data from a plurality of conventional magnetic stripe cards. The programmable memory further includes data representative of cash value as well as instructions, prompt messages and icons presented in conducting transactions. A user is enabled to operate the apparatus to select one of the accounts stored in memory, and to write account data corresponding to the selected account to the magnetic stripe of the card. The user is also enabled to use the apparatus to enter visible indicia such as bar codes and to selectively reproduce the bar codes on the display of the apparatus. The apparatus is also selectively operative to transfer funds between accounts of the user and data representative of cash value stored on the card [see col. 5 and col. 6].

According to Ramachandran, the programmable memory 18 (which serves as the claimed smart card) includes a plurality of electrical or other contacts 20 which are accessible on the front of the card. In the preferred embodiment the card and programmable memory are a type and configuration such as is commercially available

from a number of suppliers including Diebold, Incorporated, the Assignee of the present invention. The contacts 20 and the magnetic stripe 16 are positioned in predetermined locations on the card to enable the card to be used with a variety of devices. Of course in other embodiments of the invention nonconventional orientations and configurations of the magnetic stripe and the programmable memory contacts may be used [see columns 5 and 6].

Ramachandran further discloses the use of an ATM machine or a POS station for transferring data between the smart card and the magnetic stripe. Specifically, Ramachandran discloses the method for "accessing data corresponding to plurality of accounts from the memory on a single card and selectively transferring such data to a magnetic stripe or visual display in connection with the card" [see col. 3, especially lines 35-35].

Alternatively, Ramachandran's card is read by a portable data reader 14 as shown in figure 4 which comprises a non-volatile or volatile memory, a magnetic stripe card reader/writer/eraser, a scanner, a modem, a processor, interfaces and I/O port [also see the descriptions of the best mode of the invention, cols. 6-25].

As can be seen, Ramachandran discloses the claimed invention.

Regarding claim 36, figure 1 of Ramachandran shows a portable terminal 14 having slot 32; and thus would embrace all limitations set forth in this claim.

Regarding claim 37, Ramachandran discloses the use of an ATM machine or the portable terminal for specifying an amount of money transfer to be conducted; and thus would embrace all limitations set forth in this claim [also see figures 62-68].

Regarding claim 38, see the discussions regarding claim 35 of Ramachandran.

Regarding claim 39, see figures 69-74 and their descriptions.

Regarding claims 40-41, 48-49 and 51-59, all claimed limitations have been discussed above regarding the discussions set forth in claims 35-39.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 42-47, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramachandran (Ramachandran – 6,315,195) in view of Nguyen (Nguyen– 6,857,959).

Regarding claims 42-47 and 50, see the discussions above regarding the hybrid IC/magnetic strip card and the associating reader for performing account transfers.

The claims differ in calling for the use of his card and/or reader in a gaming machine.

However, this claimed limitation is not new. Reference to Nguyen is cited as evidence showing the use of smart card or magnetic strip card with a gaming machine. Specifically, Nguyen discloses a gaming machine 400, and a card reader 420 for reading magnetic stripe card or a smart card.

It would have been obvious to incorporate Ramachandran's teachings in a gaming system in the manner as suggested by Nguyen. The modification allows the hybrid card and system to be used in gaming machines; and thus extends the applications of Ramachandran's teachings.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
March 30, 2005